

REMARKS

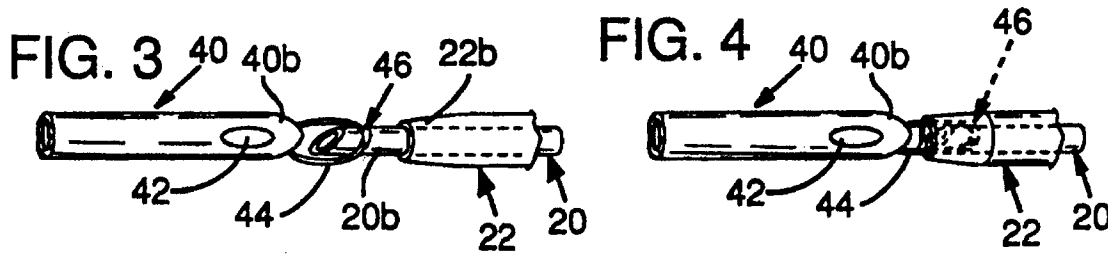
At page 2 of the Official Action, the Examiner asserts that “[t]he newly amended claims are given priority to 8/14/02, as the earlier dates of the CIP applications do not include the first and second legs as stated in the claims.” Applicants respectfully disagree with the Examiner’s conclusion. However, because the patents cited by the Examiner against the instant claims have priority dates prior to the earliest claimed priority date of the instant application, the question of whether the present claims find priority in the earliest-filed applications in the priority chain is, at present, moot.

Claim Rejections - 35 USC 103

Claims 9, 11-13, and 44-52 stand rejected under 35 USC 103(a) as purportedly obvious over Giesy et al. (US 5,152,749; hereinafter “Giesy”) in view of Skiba et al. (US 6,723,107; hereinafter “Skiba”). This rejection is respectfully traversed.

The Examiner asserts, at page 3 of the Official Action that Giesy teaches “a slotted connector” where “the distal end of the shaft includes a tapered section (Fig. 4) that is substantially straight and conical.” Applicants respectfully disagree.

The meaning of the claim term “conical” in the context of the instant application is clear and unambiguous. It is the plain and ordinary meaning of “conical,” as can be seen at, for example, Fig. 22C, 22D, 24, 25, or 26 of the instant specification. The Examiner suggests that Fig. 4 of Giesy shows a shaft that is straight and conical. Both Fig. 3 and Fig. 4 of Giesy are reproduced below. Applicants submit that the distal end 46 of the “shaft” of the rigid needle 20 of Giesy is best seen, not in Fig. 4, but in Fig. 3.



The end of the shaft 20 is clearly not conical, but instead is beveled. The beveled end can also be seen clearly in Figures 6 and 7 of Giesy. The purpose of the beveled end is to enable the needle to pierce the abdominal wall (see Col. 7, lines 24-27). Giesy simply does not teach or suggest a shaft with a conical end. This deficiency of Giesy is not remedied by Skiba, which does not teach or suggest a conical shaft end; instead Skiba teaches a shaft with an end which may be flattened (see, e.g., Skiba Fig. 1, 2, 19); blunt (see, e.g., Skiba Fig. 26); or beveled (see, e.g., Skiba Fig. 27, 28). Nor is there any motivation provided in either Giesy or Skiba to modify the teachings provided therein in order to replace the beveled end with a conical end. Accordingly, claim 45, which recites that the tapered end of the shaft is conical, is not *prima facie* obvious over Giesy in view of Skiba.

The Examiner also asserts, at p. 3 of the Official Action, that Giesy teaches that “the distal tip is blunt (Fig. 3).” Applicants respectfully disagree. As noted above, Fig. 3 of Giesy clearly shows a beveled shaft end. What is more, there is no motivation for one of ordinary skill in the art in Giesy or in Skiba to replace the beveled end of the needle 20 with a blunt end, as required by instant claim 48. Replacing the beveled end of Giesy with a blunt end would make it difficult or impossible for the needle to pierce the abdominal wall, thereby rendering the Giesy apparatus unsuitable for its intended purpose. See, e.g., *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984); see also *MPEP 2143.01.V*. Accordingly, claim 48 is not *prima facie* obvious over Giesy in view of Skiba.

The Examiner concedes, at page 3 of the Official Action, that Giesy “fails to disclose where the slotted connector includes first and second legs the first leg extending radially into the

shaft and the second leg extending axially in a distal direction from the first leg along the shaft and being longer than the first leg and includes a narrowing for locking the looped connector into the second leg.” Applicants agree.

The Examiner asserts, at page 3 of the Official Action, that these deficiencies of Giesy are remedied by the teachings of Skiba. Applicants respectfully disagree.

For example, at page 4 of the Official Action the Examiner asserts that Skiba teaches that the second leg is longer than the first leg, citing to Figure 20 of Skiba. Fig. 20 of Skiba is reproduced herein. Applicants submit that it is evident, from a casual review of Skiba Fig. 20, that the length of the first leg and the second leg are substantially equal.

The Examiner further relies on Fig. 20 of Skiba for its purported teaching of the claim requirement for a narrowing in the second leg, where it extends from the first leg. However, Fig. 20 shows no such narrowing. The diameter of the second leg in Fig. 20 is clearly the same throughout.

The Examiner also relies on Fig. 20 of Skiba for its purported teaching that the second leg of the slotted connector extends axially into the tapered section of the shaft. However, this feature is not shown or suggested in Fig. 20.

Also at page 4, the Examiner asserts that Giesy teaches that “the width of the narrowing is less than that of the loop material.” However, the Examiner does not cite to any particular part of Giesy for its teaching of this claim limitation. Applicants respectfully note that, at page 3 of the Official Action, the Examiner concedes that Giesy “fails to disclose...the second leg... includes a narrowing for locking the looped connector into the second leg.” These two

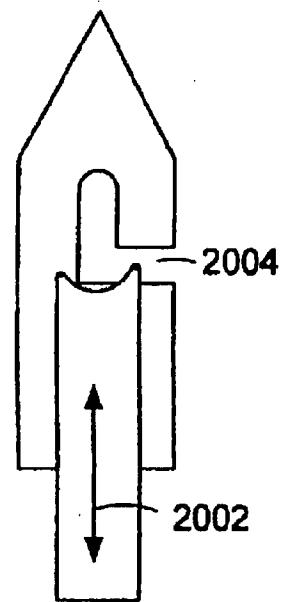


FIG. 20

statements appear to contradict each other. Applicants maintain that the statement at page 3 of the Official Action is correct, and that Giesy does not teach or suggest this claim limitation.

The Examiner concedes, at page 4 of the Official Action, that Fig. 20 of Skiba does not show a slot where the outside corner is curved and the inside corner is not curved, as required by rejected claim 52. Applicants agree. However, the Examiner relies on Figures 17 of Skiba for its purported teaching of "curved corners." Figure 17 of Skiba is reproduced herein. Applicants respectfully submit that Fig. 17 of Skiba does not show "curved corners" as argued by the Examiner. Instead, Skiba shows a slot with a semicircular first leg and a straight second leg. Fig. 17 clearly does not teach or suggest a slot with one corner that is curved and one that is not, and there is no motivation provided in Skiba, or in Giesy, to modify the slot of Fig. 17 to meet this limitation of claim 52. It should also be noted that the second leg in Fig. 17 extends proximally, not distally, as required by the rejected claims. This makes the slot of Fig. 17 incompatible with the embodiment of Skiba Fig. 20, which includes a locking mechanism (2002 in Fig. 20). Combining the slot of Fig. 17 with the locking mechanism of Fig. 20 would cause the locking mechanism to push the loop out of the slot, rather than locking it in place.

The Examiner argues, at pp. 4-5 of the Official Action that

the rounded portion of the second leg does indeed act as a locking element, the examiner directs the applicant to col. 4, lines 19, 31 and 32 where Skiba states the embodiments as shown in Fig. 14 and Fig. 16 both trap and wedge the suture. The Examiner argues that the legs in Fig. 20 would also lock the suture, as the legs in Fig. 20 are very similar to the legs in Fig. 16 where Skiba does state the suture

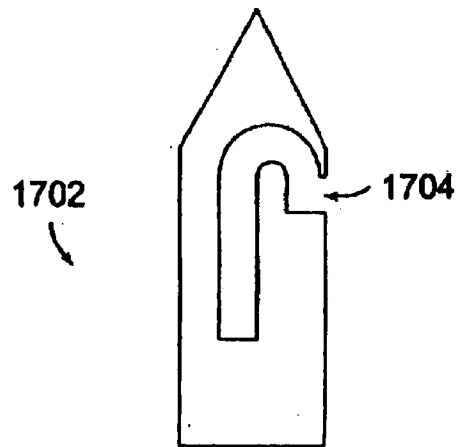


FIG. 17

is locked.

Applicants respectfully disagree.

First, it must be noted that Skiba Fig. 16 does not show a slot with two legs, as required by the present claim, but instead shows a slot with a single opening, which is wide at the point where the suture enters the slot, but narrows substantially at its proximal end. A slot of this shape might indeed lock the suture, as suggested by the Examiner. However, there is no such narrowing shown in Skiba Fig. 20. Instead, as noted above, the embodiment of Skiba fig 20 includes a separate locking mechanism to hold the suture in place. See *Skiba* col. 4, line 44 – col. 5, line 16. Fig. 14 contains no such locking element, and does not “wedge” the suture as suggested by the Examiner. Indeed, Skiba explicitly states that the slot of Fig. 14 “allow[s] the suture to slide lengthwise through the eyelet.” *Skiba*, Col. 4, lines 19-20.

For the foregoing reasons, Applicants maintain that the present claims are not *prima facie* obvious over Giesy in view of Skiba. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is respectfully requested.

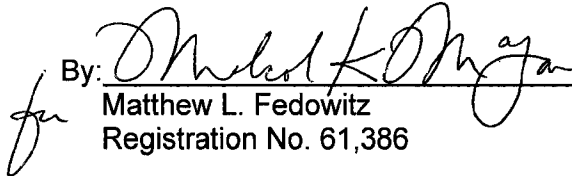
In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the Examiner would contact the undersigned attorney by telephone at (202) 373-6000 so that prosecution of the application may be expedited.

The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-4047.

Respectfully submitted,

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Date: February 4, 2011

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